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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,067	08/20/2001	Steve Brandstetter	P/94-1	6703

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EXAMINER	
COBURN, CORBETT B	
ART UNIT	PAPER NUMBER
3714	12

DATE MAILED: 07/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary	Application No.	Applicant(s)	
	09/933,067	BRANDSTETTER ET AL.	
	Examiner	Art Unit	
	Corbett B. Coburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *29 April 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 12-14, 17 & 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Quinn (US Patent Number 3,688,276).

Claim 12: Quinn teaches a game machine (16) that is a slot machine – i.e., it is a machine whose operation is begun by dropping a coin into a slot (48). The player puts in coins. (Col 4, 38-40) The machine counts the coins and the number of counted coins is shown to the player. (Col 4, 47-50) The number of coins needed for a ticket to be generated in shown to the player. (Col 4, 40-41) A ticket is dispensed when the number of counted coins equals the number of coins needed. (Col 2, 6-12)

Claim 13: The counting the coins is accomplished by counting coin pulses off of the machine's hard meter and the ticket is dispensed base on the number of coins deposited. (Col 2, 6-12)

Claim 14: The ticket is a lottery ticket. (Abstract)

Claim 17: The number of counted coins is set to zero once a ticket is dispensed. (Col 4, 47-50)

Claim 18: Quinn teaches using a remote unit to set the price of the ticket. (Col 1, 64 – Col 2, 16)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 3, 4, 6 & 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castellano et al. (US Patent Number 5,477,952) in view of Dabrowski (US Patent Number 5,544,728).

Claims 1: Castellano teaches a game machine (Col 13, 23). There is a counter for counting the number of coins a player has placed in the machine. (Col 6, 32-36) There is a means (the game machine's display) for showing the player when the ticket will be printed (i.e. when the player wins the game). There is a ticket dispenser (31). Castellano teaches that there is a readout for externally communicating the current coin count. (Col 6, 11-13) It is not clear, however, whether this readout is for visually displaying the number of coins to the player. Dabrowski teaches a visual display (126) for displaying the number of credits remaining (corresponding to the number of coins) to the player. This allows the player to see how many coins the player has inserted into the machine and how many are available for gambling. It would have been obvious to one of ordinary skill in the art at the time of the invention to have a visual display of the number of coins entered in order to allow the player to see how many coins the player has inserted into the machine and how many are available for gambling.

Claim 3: The dispensing unit is placed inside the game machine. (Col 12, 22-28)

Claim 4: The dispensing unit is an add-on to any existing gaming machine and gaming device. (Col 16, 17-20)

Claim 6: The dispensing unit is a self-contained unit that does not affect the play or outcome of the game.

Claim 8: Fig 1 clearly shows four coin slots (21-24) that correspond to different denominations (i.e., nickel, dime, quarter, and dollar).

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castellano and Dabrowski as applied to claim 1 above, and further in view of Bittner et al. (US Patent Number 5,290,033).

Claim 2: Castellano and Dabrowski teach the invention substantially as claimed. Castellano does not, however, teach mounting the device on the side of the game machine. Bittner teaches mounting an analogous device (202) on the side of the gaming machine. Castellano teaches that the device can be used a as retrofit to existing game machines. In cases where the device did not fit within the game cabinet, it would have been obvious to one of ordinary skill in the art at the time of the invention to have attached the dispensing unit to the gaming machine as a side mounted box in order to retrofit a gaming machine that did not have room inside the gaming machine cabinet.

6. Claims 5 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castellano and Dabrowski as applied to claim 1 above, and further in view of Heidel et al. (US patent Number 5,342,047).

Claim 5: Castellano and Dabrowski teach the invention substantially as claimed. Castellano teaches that the device may be attached to virtually any gaming machine.

(Col 16, 17-20) Dabrowski teaches attaching a device to a slot (i.e., gaming) machine. (Abstract) Castellano's invention is intended to detect and prevent fraud. (Abstract) Fraud is a significant problem in the gaming industry. Heidel teaches a game machine that can be used a number of different games. Heidel illustrates video poker (Fig 1) and video keno (Fig 2b). Video bingo is a well-known equivalent. Video poker, keno, and bingo are all extremely well known in the art. They are extremely popular with many players and, along with reel-type machines, form the backbone of the electronic gaming industry. It would have been obvious to one of ordinary skill in the art to have applied Castellano's coin tracker to video poker, keno, and bingo machines in order to detect and prevent fraud.

Claim 9: Castellano and Dabrowski teach the invention substantially as claimed. Castellano teaches printing a ticket as a reward, but does not teach that the ticket is a lottery ticket. Heidel teaches dispensing a lottery ticket. (Col 1, 10-18)

7. Claims 7, 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castellano and Dabrowski as applied to claim 1 above, and further in view of Piechowiak et al. (US Patent Number 6,012,982).

Claim 7: Castellano and Dabrowski teach the invention substantially as disclosed. Castellano's Fig 3 shows the counter (12) counting pulses of the game machines hard meter (52). Castellano does not, however, teach awarding the player a bonus based on the number of coins played. Piechowiak teaches a game that awards a bonus based on a player reaching a certain coin-in threshold. (Abstract) Bonuses are well known to the art and are commonly used to increase player interest. It would have been obvious to one of

ordinary skill in the art at the time of the invention to have awarded the player a bonus based on the number of coins played in order to increase interest in the game.

Claim 10: Piechowiak teaches linking games so that a combination of devices must have a certain number of coins inserted before a bonus (ticket) is dispensed. (Abstract)

Claim 11: Piechowiak teaches that there is a remote unit (122) for changing the number of coins necessary to generate the ticket.

8. Claims 15 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quinn as applied to claim 12 or 14 in view of the Big Game Lottery.

Claims 15 & 16: Quinn teaches the invention substantially as claimed. Quinn teaches dispensing lottery tickets, but does not go into the mechanics of how lotteries operate. Lotteries operate using well-known principles. The Big Game is merely one of a myriad of examples of lotteries. The winner of lotteries is determined by holding a drawing – i.e., by lot. The size of the lottery jackpot is based on the number of tickets sold. In other words, the bonus prize is based on a percentage of total coins placed into all participating gaming machines. It would have been obvious to one of ordinary skill in the art at the time of the invention to have chosen the winner of the lottery by a random drawing and to have based the jackpot on a percentage of total coins placed into the gaming machines in order to follow standard practice for running a lottery.

Response to Arguments

9. Applicant's arguments filed 219 April 2003 have been fully considered but they are not persuasive.

10. With respect to claims 1, 3, 4, 6 & 8, Applicant argues that there is no motivation to combine Castellano and Dabrowski. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is well known to the art to display the number of coins deposited in order to inform the player how many coins are available to bet. This is knowledge generally available to practitioners of the art – if a game costs a dollar to play, the player wants to know when they have put a dollar's worth of coins in the machine. The art is replete with coin-in meters for that very reason.

11. With respect to Claims 12-14, 17 & 18, Applicant argues that Quinn is not a slot machine. According to *Merriam Webster's Collegiate Dictionary, Tenth Edition* (Merriam-Webster, Incorporated, 1997, page 1106), a slot machine is, "a machine whose operation is begun by dropping a coin into a slot." Quinn meets this definition.

12. Regarding claim 2, Applicant argues that there is no motivation to combine Castellano and Dabrowski with Bittner. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re*

Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Castellano and Dabrowski suggest retrofitting coin counters to existing slot machines. Obviously, any additional hardware is going to occupy some physical space. In a case where the retrofitted coin counter cannot fit inside the slot machine cabinet, Bittner suggests a secure enclosure mounted on the outside of the cabinet.

13. Regarding claims 5 and 9, Applicant argues that there is no motivation to combine Castellano and Dabrowski with Heidel. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Castellano and Dabrowski suggest retrofitting coin counters to existing slot machines. Heidel is an example of a typical slot machine. Clearly, since they both teach combining their inventions with slot machines, Castellano and Dabrowski both provide motivation to combine with a slot machine.

14. Regarding claims 7, 10 & 11, Applicant argues that there is no motivation to combine Castellano and Dabrowski with Piechowiak. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Castellano and Dabrowski suggest retrofitting coin counters to existing slot machines. Piechowiak is an example of a typical linked slot machine. Clearly, since they both teach combining their inventions with slot machines, Castellano and Dabrowski both provide motivation to combine with a slot machine.

15. With respect to Claims 15 & 16, Applicant argues that Quinn is not a slot machine. According to, a slot machine is, "a machine whose operation is begun by dropping a coin into a slot." Quinn meets this definition.

1.132 Declaration

16. Regarding the Declaration of Campbell, this declaration does not appear to be timely filed. MPEP §716.01 states:

> The following criteria are applicable to all evidence traversing rejections submitted by applicants, including affidavits or declarations submitted under 37 CFR 1.132:
>
> (A) Timeliness . Evidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. In re Rothermel, 276 F.2d 393, 125 USPQ 328 (CCPA 1960). Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:
> (1) prior to a final rejection,
> (2) before appeal in an application not having a final rejection, or
> (3) after final rejection and submitted
> (i) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, or
> (ii) with a satisfactory showing under 37 CFR 1.116(b) or 37 CFR 1.195, or
> (iii) under 37 CFR 1.129(a).

The declaration fails to meet the criteria set out in MPEP§7.16(A)(3). Specifically, the declaration does not limit itself to overcoming a new ground of rejection or requirement made in the final rejection.

17. Even if timely, the declaration under 37 CFR 1.132 filed 8 April 2003 would be insufficient to overcome the rejection of claims 1-18 based upon 35 USC §102 & §103 as set forth in the last Office action because: The declaration amounts to little more than a statement that Mr. Campbell has never seen the claimed invention. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *Merriam Webster's Collegiate Dictionary, Tenth Edition* (Merriam-Webster, Incorporated, 1997, page 1106) gives the definition of "slot machine".

19. This is a RCE of applicant's earlier Application No. 09/933,067. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

GJCR

cbc
July 3, 2003

JESSICA HARRISON
PRIMARY EXAMINER